

Appl. No. 10/673,062
Amdt. dated August 11, 2004
Reply to Office action of May 11, 2004

1884-0002

REMARKS

I. Status of the Application

Claims 1-11 are pending in this application. In the May 11, 2004 office action, claims 7-11 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as the invention. In addition, claims 1-3 and 7-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent no. D443,971 to Carr et al. (hereinafter, "Carr") in view of U.S. patent application publication no. 2002/0157294 to Stanley (hereinafter, "Stanley"). Furthermore, the claims 1, 4, 5, 7, 8, and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Carr in view of U.S. patent no. 5,102,171 to Sactre (hereinafter, "Sactre"). Finally, the examiner indicated that claim 6 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

In this response, Applicants have amended claims 7 and 8. Applicants respectfully request reconsideration of pending claims 1-11 in view of the foregoing amendments and the following remarks.

II. The Rejection of Claims 7-11 Under 35 U.S.C. § 112 Should be Withdrawn

In the May 11, 2004 office action, claims 7-11 were rejected as indefinite under 35 U.S.C. §112, second paragraph. Applicants have amended claims 7 and 8 to overcome each of the examiners cited reasons for rejection. Accordingly, the rejection of claims 7-11 under 35 U.S.C. §112 should be withdrawn.

III. The Obviousness Rejection of Claims 1-5 and 7-11 Should be Withdrawn

Claims 1-3 and 7-10 stand rejected under 35 U.S.C. §103(a) as obvious over Carr in view of Stanley. Claims 1, 4, 5, 7, 8 and 11 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Carr in view of Sactre. Claims 1 and 8 are independent.

Applicants respectfully traverse these rejections because the expressed grounds for the rejections fail to make a *prima facie* case of obviousness under MPEP §2142. In order to make a *prima facie* case of obviousness, all claim limitations must be taught or

Appl. No. 10/673,062
Amdt. dated August 11, 2004
Reply to Office action of May 11, 2004

1884-0002

suggested by the prior art. MPEP § 2143.03. In this case, Applicants submit that the limitations found in independent claims 1 and 8 of "the flexible sheet having a perimeter configured to substantially conform to the perimeter shape of the mailbox door" are not suggested or taught by the prior art.

As noted in the office action, none of the art of record, including Carr and Stanley, discloses a flexible sheet with a perimeter configured to substantially conform to the perimeter shape of a door. However, it was suggested that it would have been an obvious design choice to utilize a flexible sheet having a perimeter configured to substantially conform to the perimeter shape of the door, as a change in the shape of a prior art device is a design consideration within the skill of the art.

A. The Prior Art Teaches Away from the Claimed Invention

Applicants' limitation that the perimeter of the flexible sheet is configured to substantially conform to the perimeter shape of a mailbox door is not a mere design choice. In particular, changing the shape of an article is not a mere design choice if the prior art teaches away from such a change in shape. *See, In re Fine*, 873 F.2d 1071 (Fed. Cir. 1988). A prior art reference that teaches away from the claimed invention is a significant factor to be considered in determining obviousness. MPEP 2145. Furthermore, when the totality of the prior art is considered, proceeding contrary to accepted wisdom in the art is evidence of nonobviousness. *In re Hedges*, 783 F.2d 1038 (Fed. Cir. 1986); MPEP 2145.

In the present case, the prior art teaches a flexible material that has a perimeter shape of an aesthetic design such as a flag, star, letters, etc. The prior art does not contemplate an appliqué with the perimeter shape of the structure to which the flexible material is to be attached. As evidenced by both the Stanley and Saetre references, the accepted wisdom in the art is to provide an appliqué in which the appliqué's perimeter shape is itself an aesthetic design. Changing the shape of these appliqués would destroy their function and purpose. For example, changing the shape of the individual letter appliqués that spell "HAPPY" in Stanley would of course render them worthless. The prior art teaches that the shape of an appliqué is important for its aesthetic appearance, not because it conforms to another object. There is no suggestion in the cited art to shape

Appl. No. 10/673,062
Amdt. dated August 11, 2004
Reply to Office action of May 11, 2004

1884-0002

the perimeter of the flexible material to substantially conform to the perimeter shape of an object on which the flexible material will be placed.

Providing a flexible material with a shape that substantially conforms to the perimeter shape of a mailbox door is not a mere design choice, but instead provides several operational advantages not seen in the art of record. For example, as set forth on page two of the present application, a typical mailbox door includes a peripheral rib around its perimeter. Applicants' claimed invention is designed to adhere to the door in association with this peripheral rib, so that the flexible material may be protected by fitting within the peripheral rib. In addition, providing a flexible material as recited in claims 1 and 8 allows for maximized and uniform coverage of the door with the graphic display, while preventing interference of the flexible material with the door. Flexible material configured in a shape shown by the prior art would either block the door from opening and/or closing or would not provide maximized and uniform coverage of the door with a display. Therefore, Applicants' claimed invention performs differently than the prior art and is therefore patentably distinct from the prior art. *See* MPEP 2144.04.

B. There is No Motivation to Combine the References

The grounds set forth in the Office Action have failed to establish a prima facie case for obviousness because there is no motivation to make the suggested combination. Carr is cited because it shows a decorative mailbox. Nearly the entire mailbox carries the ornamental design to emulate hummingbirds in a flower garden. Carr only teaches providing a particular ornamentation on a mailbox. At best, the reference teaches that a mailbox, like countless other products, can be decorated to blend better with its surroundings. Carr does not teach any particular way that the decoration is applied, nor does it matter for the purpose of this design patent.

The mere fact that Carr teaches decorating a product does not rise to the level of suggesting any particular decorating technique beyond what would be conventional. For a product of this sort one can envision that such a conventional approach would be painting or surface printing. Beyond that, there is nothing in Carr, or in any design patent for that matter, that would compel a person of skill in the art to seek out non-conventional decorating techniques, let alone the approaches described in the Stanley or Sactre

Appl. No. 10/673,062
Amdt. dated August 11, 2004
Reply to Office action of May 11, 2004

1884-0002

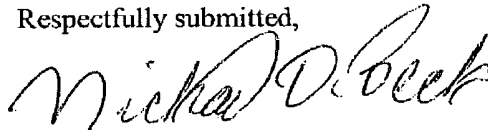
references.

It is not enough for Carr to suggest decorating a mailbox. For a *prima facie* case of obviousness, there must be something to motivate a person of skill to be drawn to Stanley or Saetre. No such motivation has been provided in the Office Action. The only statements attempting to support the combination are merely recitations of the physical properties of the Stanley and Saetre appliques. (See, Office Action page 3, lines 14-16, and page 5, lines 2-5). There is no explanation given as to why one would turn to Stanley or Saetre to perfect the Carr design. Merely repeating the physical properties of a secondary reference does satisfy the *prima facie* requirement of showing some motivation for the combination. This approach is no better than stating that it would be obvious to paint the mailbox with a radioactive dye because the dye is radioactive.

IV. Conclusion

As set forth above, a *prima facie* case has not been made that claims 1 and 8 are unpatentable as obvious under 35 U.S.C. § 103(a) over Carr in view of either Stanley or Saetre. Accordingly, it is respectfully submitted that the claims 1 and 8 are patentable over the art of record, along with the previously rejected dependent claims 2-5, 7, and 9-11. For all of the foregoing reasons, it is respectfully submitted the present application is in condition for allowance. Favorable reconsideration and allowance of this application is, therefore, respectfully requested.

Respectfully submitted,



Michael D. Beck
Attorney Registration No. 32,722

Maginot Moore & Beck
Bank One Center Tower
111 Monument Circle, Suite 3000
Indianapolis, Indiana 46204-5130
Telephone: (317) 638-2922
Facsimile: (317) 638-2139
Email: mdbeck@maginot.com